

Remarks

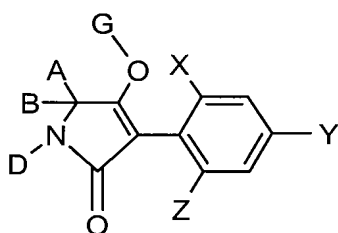
Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 3-6, 8, 9, 11-15 and 17-19 are pending in the application, with claims 3 and 17-19 being the independent claims. Claims 1, 2, 7, 10 and 16 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 3-6, 8, 9, 11-15 and 17-19 have been amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Description of the Invention


The present invention relates to novel compounds of formula (I),



(I)

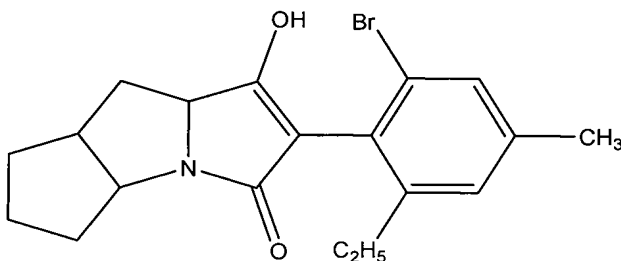
to a plurality of processes and intermediates for their preparation and to their use as pesticides and/or herbicides. The invention also relates to novel selective herbicidal active compound combinations compounds of formula (I) and at least one crop plant

II. Objections to the Specification

states that "the structure  occupied the space of both substituents A and D and the structure is a linker with an open bond at the both end..."

Office Action, p. 4.

Rather, the group links the atoms substituted by groups A and D. Therefore, the CH₂ group is attached to the carbon atom of formula I to which the group A is attached and the CH group of the above structure is attached to the nitrogen atom of formula I to which group D is attached. Therefore, the structure of compound I-a-4, having the above structure as substituent A and D is:

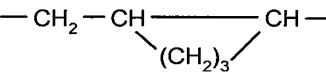


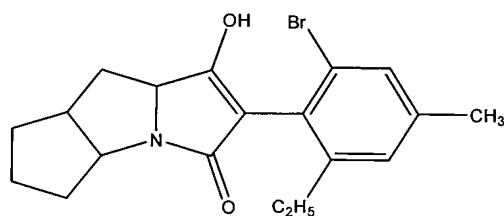
In view of this clarification, Applicants respectfully request that the objection be withdrawn.

III. Rejections under 35 U.S.C. § 112

The rejection of claims 1-5 and 8 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is respectfully traversed. In view of the cancellation of claims 1 and 2, the rejection of claims 1 and 2 is rendered moot.

The Office has stated that the elected species compound I-a-4 is indefinite because the definition of A and D at the table on page 94 of the specification is not clear

because the structure  occupied the space of both substituents A and D. Office Action, p. 5. The Applicants respectfully reiterate the arguments presented above and submit that the Office has incorrectly interpreted substituents A and D and provide that the structure of compound I-a-4 is:

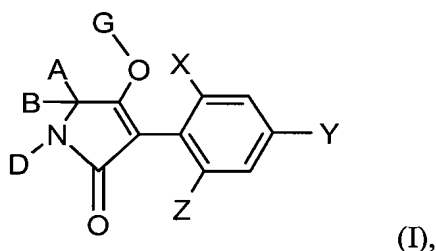


In view of the clarification, Applicants respectfully submit that the rejection of claims 3-5 and 8 is improper and request that the rejection be withdrawn.

IV. Rejections under 35 U.S.C. § 103(a)

The rejection of claims 1-5 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,469,196 to Fischer *et al.* ("the '196 patent") is respectfully traversed. In view of the cancellation of claims 1 and 2, the rejection of claims 1 and 2 is rendered moot.

Claim 3, as amended, is directed to a compound of formula I



wherein X is chlorine or bromine, Y is methyl or ethyl and Z is ethyl or n-propyl.

The Office states that the instantly claimed compounds would have been allegedly obvious over the '196 compounds because the '196 patent teaches herbicides and/or pesticides, which have the same utility as the instantly claimed compounds. Office Action, p. 7. Applicants respectfully disagree.

Applicants claims as amended are directed to compounds wherein the Z group is an ethyl or isopropyl substituent. The Office has provided no explanation why a person of ordinary skill in the art would select a specific compound from the '196 patent with the corresponding X, Y and Z substitution pattern of the instantly claimed compounds as a starting point from among the hundreds of compounds recited by the '196 patent. The Office has also failed to provide a rationale as to why a person of ordinary skill in the art

would replace methyl with any other alkyl at the Z position. The rationale the Office has provided is not sufficient to modify the selected lead compound in such a way as to arrive at the current invention. Accordingly, claims 3-5 and 8 are not *prima facie* obvious in light of the '196 patent and the rejection should be withdrawn.

Even assuming that a *prima facie* case of obviousness has been established, which it has not, the unexpected herbicidal action exhibited by the claimed compounds is sufficient to overcome any *prima facie* case of obviousness. Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 ("Declaration") which recites the unexpected superiority of compounds of the claimed invention over the '196 patent. In the Declaration, chemist Dr. Heinz Kehne, an inventor of the above-identified application, recites data from pre and post emergence herbicidal action of the compounds of the present invention to compounds from PCT Publication No WO 97/02243 (patent family member equivalent of the '196 patent). The results therein illustrate that a compound of the present invention with an ethyl group at the Z position were unexpectedly superior to the compounds from the '196 patent even at lower levels of application. Kehne's Declaration, pages 2-8. For example, compound 1-b-2 of the present invention exhibits an efficacy of 100% in the destruction of Setvi and ECHCG weeds at an application rate of 80 g/ha when compared to a 20% and 70% efficacy of a compound from the '196 patent applied at a rate of 250 g/ha. *Id.*, at page 2. A second illustrative compound, 1-b-18, also demonstrates an efficacy of 100%, 100% and 90% in the destruction of Setvi, Avefa and Alomy weeds respectively, at an application rate of 80 g/ha. In comparison, a compound from the '196 patent has an efficacy of 90%, 80% and 50%, in each of the weeds respectively, when applied at a rate of 250 g/ha. *Id.*, at page 6.

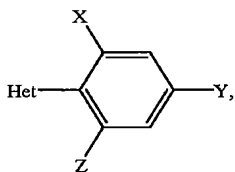
The data, therefore, shows that when exemplary compounds of the present invention are compared against an exemplary compound of the '196 patent in the same experiment, the compound of the present invention showed superior weed killing activity. *Id.*

V. Double Patenting

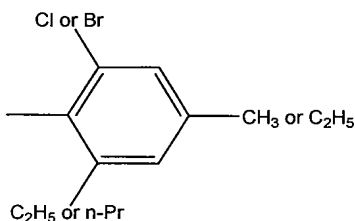
The rejection of claims 1-5 and 8 as allegedly being unpatentable on the ground of obviousness-type double patenting over claims 1-4, 6 and 8 of U.S. Patent No. 5,994,274 (the '274 patent) is respectfully traversed.

The Office has stated that it would have been obvious to one of ordinary skill to make compounds of the instant claims given the '274 patent because the compounds of the '274 patent allegedly anticipate compounds of the instant claims. Office Action, p. 8. Applicants respectfully disagree.

The claims of the '274 patent disclose compounds of formula



wherein, X represents alkyl, Y represents halogen or alkyl and Z represents halogen or alkyl. The claims of the present invention, in contrast are drawn to compounds of formula (I), wherein the specific substitution pattern of the phenyl radical is:



The claims of the '274 patent disclose thousands of compounds. The Office has not provided a reason why a person of ordinary skill in the art would choose a compound wherein X is chlorine or bromine, Y is methyl or ethyl and Z is ethyl or n-propyl as a lead compound from among the thousands of compounds recited by the '274 patent. The rationale the Office has provided is not sufficient to modify the selected lead compound in such a way as to arrive at the current invention. Accordingly, it would not have been obvious to one of ordinary skill in the art to make the compounds of the instant claims. Applicants respectfully request that this rejection be withdrawn.

VI. *Objections to the Claims*

Claims 1-5 and 8 are provisionally objected to for containing elected and non-elected subject matter. In view of the cancellation of claims 1 and 2, the objection to claims 1 and 2 is rendered moot. Applicants respectfully traverse the objection to claims 3-5 and 8. In the Reply to Restriction Requirement filed on December 3, 2008, Applicants elected Group I represented by claims 1-5 and 8. It is unclear how these claims contain non-elected subject matter. Applicants respectfully request that the objection be withdrawn.

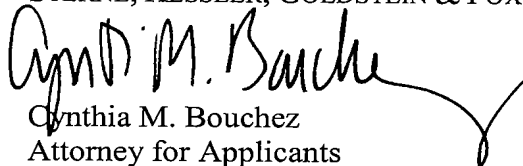
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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